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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,699	01/23/2002	Hans Jurgen Bigus	19075.0	8262

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EXAMINER

BUTLER, MICHAEL E

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 11/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/031,699

Applicant(s)

Bigus et al.

Examiner

Michael E. Butler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Aug 25, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 24-46 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 6) ☐ Other:

## **DETAILED ACTION**

### ***Priority***

1. Applicant's claim of priority as a national stage 371 application of application of PCT/DE00/02191 filed 6/29/00 which claims priority to application 199 35 634.3 filed 07/29/1999 in Germany is acknowledged.

### ***Drawings***

2. New drawings will be required contingent upon allowance because the drawings were declared informal by the applicant.

### ***Election/Restriction***

3. Applicant's election of invention II with traverse of the restriction requirement in Paper No. 6 is acknowledged and made final.

Examiner notes the amendment of the elected special technical features into claims 24-36 and the removal of the nonelected special technical feature into claims 24-36.

### ***Claim Rejections - 35 USC § 101***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 24-36 are rejected under 35 U.S.C. 101 as being directed at two differing and distinct statutory classes of invention-process and machine. Dependent method claims must depend from method claims-not apparatus claims.

### ***Claim Rejections - 35 USC § 112***

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6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 24-46 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention {and as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It is not apparent how a means for defining receptacles performs a U-shaped defining.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 24-46 are rejected under 35 U. S. C. 112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not apparent what structure is claimed by a means for defining.

There is a lack of antecedent basis in the claims for the capillaries (cl: 37- applicant has identified a dispenser for use with capillaries not provided antecedent basis for the capillaries); (Re: cl 45) U-shaped legs.

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***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 24-39, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mochida in view of Keenan et al. which discloses the elements previously discussed and further discloses:

(re: cl 37) A dispenser comprising:  
means defining at least one receptacle for the capillaries, receptacle having U-legs separated by at least said length of the capillaries to guide ends of the U-shaped receptacle (17)  
upwardly disposed guide (18) defining a slot between guide and U-shaped receptacle (fig 2)  
guide having open access for tape holding capillaries (c9 L 60-68)  
adhesive tape removable from capillaries when supported by guide (c10 L 57-58).  
(Re: cl 38) two guide members facing each other (18 fig 2)  
(Re: cl 39) guide element at a separation from the U-shaped receptacle (fig 2)  
(Re: cl 43) Means for winding capillaries about an axle (16 FIG 2 about 15)  
at end of 7 is approximately diameter of capillary);

Keenan et al. discloses any elements that Mochida does not explicitly disclose including:

tape less than half the width of the capillary length (66 vs. 30);  
disposing capillaries in parallel alignment on tape at separations less than diameters (c5 L 5-45 with fig 1 & 2).

It would have been obvious at the time of the invention for Mochida to use a narrower tape width for ease of removal as taught by Keenan et al.. It would have been obvious at the time of the invention for Mochida to place capillaries proximate each other within a diameter width for compact storage as taught by Keenan et al..

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12. Claims 37, 40-42, and 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sjoboen (University of Washington on 1449) in view of Keenan et al. which discloses the elements previously discussed and further discloses:

(re: cl 37) A dispenser comprising:  
means defining at least one receptacle for the capillaries, receptacle having U-legs (44) separated by at least said length of the capillaries to guide ends of the U-shaped receptacle (38)  
upwardly disposed guide (42) defining a slot between guide and U-shaped receptacle  
guide having open access for tape holding capillaries (26)  
(Re: cl 40) slider (46)  
(Re: cl 41) means for loading capillaries into slotted guide (32)  
(Re: cl 42) diameter of discharge corresponds to the diameter of the capillaries (48 fig 1).  
(Re: cl 44) dispenser structured for axial removal of capillaries (end of 48)  
(Re: cl 45) dispensing location has opening level with capillary penetrating (exit from end of 48)  
(Re: cl 46) opening diameter corresponds to diameter of capillaries (48 corresponds in diameter to capillaries).

Keenan et al. discloses any elements that Sjoboen does not explicitly disclose including:

adhesive tape removable from capillaries when supported by guide tape less than half the width of the capillary length (66 vs. 30);

disposing capillaries in parallel alignment on tape at separations less than diameters (c5 L 5-45 with fig 1 & 2).

It would have been obvious at the time of the invention for Sjoboen to use a narrower tape width for ease of removal as taught by Keenan et al.. It would have been obvious at the time of the invention for Sjoboen to place capillaries proximate each other on the tape within a diameter width for compact storage as taught by Keenan et al..

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***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exmr. Michael E. Butler whose telephone number is (703) 308-8344.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh, can be reached on (703) 306-4173. The fax number for the Group is (703) 305-7687.

*Michael E. Butler*

Michael E. Butler

Examiner

*Donald P. Walsh*

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